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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/735,749

12/16/2003

Leonard C. Monteleone

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EXAMINER

SCARITO, JOHN D

ART UNIT

PAPER NUMBER

3696

MAIL DATE

DELIVERY MODE

12/10/2008

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

<p align="center">Advisory Action Before the Filing of an Appeal Brief</p>	<p>Application No. 10/735,749</p>	<p>Applicant(s) MONTELEONE ET AL.</p>	
	<p>Examiner John D. Scarito</p>	<p>Art Unit 3696</p>	

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 21 November 2008 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☒ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

- a) ☒ The period for reply expires 3 months from the mailing date of the final rejection.
- b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.

Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

NOTICE OF APPEAL

2. ☒ The Notice of Appeal was filed on 11/21/2008. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

AMENDMENTS

3. ☒ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because
- (a) ☒ They raise new issues that would require further consideration and/or search (see NOTE below);
- (b) ☐ They raise the issue of new matter (see NOTE below);
- (c) ☐ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
- (d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: See Continuation Sheet. (See 37 CFR 1.116 and 41.33(a)).

4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).
5. ☐ Applicant's reply has overcome the following rejection(s): _____.
6. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
7. ☒ For purposes of appeal, the proposed amendment(s): a) ☒ will not be entered, or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.
- The status of the claim(s) is (or will be) as follows:
- Claim(s) allowed: None.
- Claim(s) objected to: None.
- Claim(s) rejected: 1-42.
- Claim(s) withdrawn from consideration: None.

AFFIDAVIT OR OTHER EVIDENCE

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).
9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing a good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).
10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

REQUEST FOR RECONSIDERATION/OTHER

11. ☒ The request for reconsideration has been considered but does NOT place the application in condition for allowance because:
See Continuation Sheet.
12. ☐ Note the attached Information *Disclosure Statement*(s). (PTO/SB/08) Paper No(s). _____
13. ☒ Other: See Continuation Sheet.

/Frantzy Poinvil/
Primary Examiner, Art Unit 3696

Continuation of 3. NOTE: Examiner thanks Applicant for reviewing the minor claim objections and 112-2nd paragraph rejections of the last Office Action. Applicant's claims are complex, thus clarity and consistency in claim language are key. However, upon reviewing Applicant's amendments, Examiner notes at least the following changes that either broaden or further limit Applicant's claims. First, in at least Claims 3, 9 & 24, Applicant eliminates the phrase "based on pertinent information concerning each said mortgage backed security, including". Here, for instance, Applicant broadens his claim by no longer requiring "analysis" (Claim 1) to be "based on pertinent information" (Claim 3). Next, Examiner objected to "consolidation of mortgage-backed securities" as lacking antecedent basis. [see Final Office Action, page 8, lines 7-8] Here, in at least Claims 22-27, 33, 34, 36-38, Applicant went beyond correcting an antecedence issue to claim "a consolidation of at least some of said mortgage-backed securities" (Claim 22). Examiner suspects that through "at least some of" Applicant may be alluding to a consolidation situation where "retained" mortgage backed securities are involved [see Applicant's Specification, pages 15-16, paragraph 45] of which Examiner has not previously considered. Per MPEP 714.20, "the general rule prevails than an amendment should not be entered in part".

Continuation of 11. does NOT place the application in condition for allowance because:

Examiner finds Applicant's arguments unpersuasive.

First, with regard to Applicant's comments on Double Patenting [After-Final Amendment, pages 23-24], Examiner will hold the requirement for a Terminal Disclaimer in abeyance. However, Examiner notes that per 37 CFR 1.111(b) only "objections or requirements as to form" are normally held in abeyance. [Final Office Action, page 4, lines 6-14, i.e. not rejections, even if provisional]. Examiner will continue to keep said rejection of record until Applicant distinguishes Claim 4 of Application 11/129, 334.

Next, as a foundational issue, Examiner notes Applicant's immediate resort to his/her Specification to define "inventory" [see After-Final Amendment, page 25, line 27- page 26, line 8]. Examiner has been unable to find an explicit definition for "inventory" in Applicant's Specification. As such, Examiner is able to take a broadest reasonable interpretation of "inventory" (i.e. a group of assets, e.g. could be an order) and will not read any of the limitations to which Applicant refers, i.e. from the Specification, into that term (or the claim for that matter). Similarly, Applicant does not provide an explicit definition for "indicia". As such, Examiner asserts that his current interpretations are legitimate until Applicant particularly includes his intended meaning of said terms in his Claims. In the same vein, Applicant merely states "based on an analysis" (see Claim 12). Although Applicant asserts that "'analysis'....requires the matching of certain 'indicia' of the MBS pools" [After-Final Amendment, page 27, line 16], Examiner has been unable to find such a limitation in Applicant's claims. In sum, Examiner thanks Applicant for the examples provided in his/her After-Final Amendment. However, Examiner asserts that many of Applicant's arguments and such a reading of the invention is not yet justified since many of Applicant's interpretations are not supported or particularly limited through Applicant's currently presented claims. For instance, Examiner requests Applicant to reconsider Claim 1. Here, if "inventory" and "indicia" and "analysis" are given their broadest reasonable interpretation (i.e. because no explicit definition for said terms is provided in Applicant's specification) said claim is very broad and reads on Examiner's art of record as presented in his previous office actions.

Continuation of 13. Other: Applicant contends that "Examiner's assertion that structure is required to carry out the steps of a method claim is inconsistent with current case law" [After-Final Amendment, page 24, lines 22-23]. Examiner respectfully points Applicant to *In re Bilski*, ___ F.3d ___ (Fed. Cir. 2008)(en banc, decided 10/30/2008). Next, Applicant appears to question Examiner's assertion that recitation of "'computer-based' in the preamble is inadequate as a mere nominal recitation of structure". [After-Final Amendment, page 24, line 21]. Examiner respectfully points Applicant to the BPAI's informative decision *Ex Parte Langemyr* (BPAI, decided 5/28/2008) at at least page 20.